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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,812	12/28/2000	Charles A. Eldering	T733-10	8268
27832	7590	02/23/2005	EXAMINER	
TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME			MANNING, JOHN	
6206 KELLERS CHURCH ROAD			ART UNIT	
PIPERSVILLE, PA 18947			PAPER NUMBER	
			2614	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/750,812

Applicant(s)

ELDERING ET AL.

Examiner

John Manning

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed November 3, 2004 have been fully considered but they are not persuasive.
2. The Applicant argues that Bryant fails disclose creating a plurality of subavails, wherein each subavails is directed to a particular target audience group, and aggregating the subavails to generate one or more groups of subavails. As stated in the previous Office Action, the subavails are met by the program segments 310 and 320 of Figure 3. Furthermore, in "a preferred embodiment of the invention, the segments 310 and 320 are separately identified as described below. During distribution of the program, the broadcaster or cable operator can insert segments and select segments based on the identification of the segments. If the selection is done in the STB 200, individual customers can be targeted" (Col 5, Lines 34-39). Clearly, the segments 310 and 320 are directed to a particular target audience group. Applicant argues that the invention was owned by, or subject to an obligation of assignment to, the same entity as the Eldering reference at the time this invention was made. Accordingly, the Eldering reference is disqualified as prior art through 35 U.S.C. 102(f) or (g) in any rejection under 35 U.S.C. 103(a) in this application. However, this applied art additionally qualifies as prior art under another subsection of 35 U.S.C. 102 and accordingly is not disqualified as prior art under 35 U.S.C. 103(a). Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by

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another," or by antedating the applied art under 37 CFR 1.131. The Applicant has requested a reference for the OFFICIAL NOTICE that it is notoriously well known to have advertisements that are gathered from the same channel. The Swix et al. (US Pat App Pub No 2004/0163101) discloses advertisements that are gathered from the same channel. "The separate advertisement channel can be either another programming channel whose advertisement insertion slots coincide with program broadcast 500 or can be a continuous stream of advertisements with no programming. The continuous stream of advertisements is preferred if the intervals of the advertisements line up with the programming channels that switch to it. In FIG. 5, channel 516 represents a continuous stream of advertisements to which program broadcast 500 can off-tune, e.g., to off-tune to Ad X for advertisement insertion slot 2. Optionally, instead of tuning to video advertisements, a set-top box could retrieve bit map advertisements spooled in a broadcast carousel format. The advantage of off-tuning the set-top box is a savings in bandwidth. Instead of delivering a separate video stream with targeted advertisements to each demographic group of subscribers, the off-tuning uses only one continuous broadcasting channel and tunes to other channels to deliver targeted advertisements" (Paragraphs 0078-0079).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 10, 12, 14, 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Bryant et al. (US Pat No 5,652,615).

In regard to claim 1, Bryant discloses a system and method of distributing demographically targeted advertisements. The claimed step of "recognizing one or more advertisement opportunities (avails)" is met by Figure 1. "Program segments 310 and 320, according to the invention, can be inserted or selected at points 110, 111, 120, 131, 140, 150, 160, 170 of the network 100" (Col 5, Lines 23-25). By inserting the program segments 310 and 320, the system inherently recognizes the advertisement opportunities. The claimed step of "creating a plurality of subavails based on the recognized avails, wherein each of the subavails is directed at a particular target audience group" is met by Figure 1. "The segments are adjacently arranged in a temporal manner, substantially without overlap, and with the base and fill segments alternating" (Col 4, Lines 48-50). "The different fill segments 320 can be separately identified" (Col 5, Lines 10-11). "In a preferred embodiment of the invention, the segments 310 and 320 are separately identified as described below. During distribution of the program, the broadcaster or cable operator can insert segments and select segments based on the identification of the segments. If the selection is done in the STB 200, individual customers can be targeted" (Col 5, Lines 34-39). The claimed step of "aggregating the subavails to generate one or more groups of subavails" is met by Figure 3. "It is proposed that multiple fill segments be concurrently carried on the circuit

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assigned to the program during their allocated time periods" (Col 5, Lines 4-6).

Therefore, the fill segments or "subavails" are grouped.

In regard to claim 4, Bryant discloses gathering subscriber characteristics of the target group and determining a correlation between the subscriber group and the subavails. "The memory buffer 230 can also store data which is a "profile" of the customer demographics, e.g., age, income, location, etc. The profile can be used to selectively decode the broadcast signals as explained below" (Col 4, Lines 2-5).

In regard to claim 10, discloses that the subavails are grouped by combining a plurality of time-sequenced subavails. "The segments are adjacently arranged in a temporal manner, substantially without overlap, and with the base and fill segments alternating" (Col 4, Lines 48-50).

In regard to claim 12, Bryant discloses a system and method of distributing demographically targeted advertisements. The claimed limitation of "an avail opportunities recognition module for recognizing advertising opportunities" is met by Figure 1. "Program segments 310 and 320, according to the invention, can be inserted or selected at points 110, 111, 120, 131, 140, 150, 160, 170 of the network 100" (Col 5, Lines 23-25). By inserting the program segments 310 and 320, the system inherently recognizes the advertisement opportunities. The claimed limitation of "a subavail generation module for creating a plurality of subavails based on the recognized avails" is met by Figure 1. "The segments are adjacently arranged in a temporal manner, substantially without overlap, and with the base and fill segments alternating" (Col 4, Lines 48-50). "The different fill segments 320 can be separately identified" (Col 5, Lines

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10-11). "In a preferred embodiment of the invention, the segments 310 and 320 are separately identified as described below. During distribution of the program, the broadcaster or cable operator can insert segments and select segments based on the identification of the segments. If the selection is done in the STB 200, individual customers can be targeted" (Col 5, Lines 34-39). The claimed limitation of "a subavil aggregation module for aggregating the subavails to generate one or more groups of subavails" is met by Figure 3. "It is proposed that multiple fill segments be concurrently carried on the circuit assigned to the program during their allocated time periods" (Col 5, Lines 4-6). Therefore, the fill segments or "subavails" are grouped.

In regard to claim 14 and 15, Bryant discloses gathering subscriber characteristics of the target group and determining a correlation between the subscriber group and the subavails. "The memory buffer 230 can also store data which is a "profile" of the customer demographics, e.g., age, income, location, etc. The profile can be used to selectively decode the broadcast signals as explained below" (Col 4, Lines 2-5).

In regard to claim 17, discloses that the subavails are grouped by combining a plurality of time-sequenced subavails. "The segments are adjacently arranged in a temporal manner, substantially without overlap, and with the base and fill segments alternating" (Col 4, Lines 48-50).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3, 5-9, 11, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant et al. in view of Eldering (WO 00/33163).

In regard to claim 2, Bryant discloses a system and method of distributing demographically targeted advertisements. Bryant fails to explicitly disclose "selling the groups of subavails to one or more prospective advertisers". Eldering teaches selling advertisements opportunities to one or more advertiser so as to generate revenue for the content provider. "In a preferred embodiment of the present invention, a pricing policy can be defined. The content/opportunity provider 160 can charge advertiser 144 for access to consumer 100 during an opportunity" (Page 9, Lines 1-4). Consequently, it would have been obvious to one of ordinary skill in the art to modify Bryant to sell advertisements opportunities to one or more advertiser so as to generate revenue for the content provider.

In regard to claim 3, Eldering discloses that advertiser 144 send a bid to the content provider as shown in Figure 7. "Advertiser 144 transmits a bid contained within a bid message 730. The bid represents the amount that an advertiser is willing to pay for a transmission opportunity" (Page 23, Lines 7-9). Eldering also discloses selling the advertisement opportunity to the highest bidder. "Once the content/opportunity provider



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160 has determined an acceptable bid, an acceptance message 740 is sent to advertiser 144" (Page 23, Lines 20-22). Where acceptable bit is interpreted to be the highest bid.

In regard to claim 5, Bryant discloses a system and method of distributing demographically targeted advertisements. Bryant fails to explicitly disclose the "determining pricing for the groups of subavails based on the correlation". Eldering teaches determining pricing for the groups of subavails based on the correlation so as to maximize revenue for the content provider. The "price charged for access to consume 100 by content/opportunity provider varies as a function of the applicability of the advertisement to consumer 100" (Page 9, Lines 5-8). Consequently, it would have been obvious to one of ordinary skill in the art to modify Bryant with determining pricing for the groups of subavails based on the correlation so as to maximize revenue for the content provider.

In regard to claim 6, it is inherent that that the groups of subavails are sold based on the determined pricing. The "price charged for access to consume 100 by content/opportunity provider varies as a function of the applicability of the advertisement to consumer 100" (Page 9, Lines 5-8).

In regard to claim 7, the Bryant discloses a system and method of distributing demographically targeted advertisements. Bryant fails to explicitly disclose the claimed steps of "transmitting the correlation results to one or more prospective advertisers", "receiving one or more bids for each group of subavails" and "selling the group of subavails to the highest bidder". The Eldering reference teaches the steps of

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"transmitting the correlation results to one or more prospective advertisers", "receiving one or more bids for each group of subavails" and "selling the group of subavails to the highest bidder" as show in Figure 7 so as to maximize revenue for the content provider.

"As illustrated in FIG. 7, the combined correlation and pricing/fee message 720 is received by content/opportunity provider 160, who transmits the correlation result to advertiser 144" (Page 22, Lines 33-34; Page 23, Lines 1-2). "Advertiser 144 transmits a bid contained within a bid message 730. The bid represents the amount that an advertiser is willing to pay for a transmission opportunity. In a preferred embodiment the bid is calculated by advertiser 144 based on the results of the correlation" (Page 23, Lines 7-11). The claimed step of "selling the group of subavails to the highest bidder" is implied. Consequently, it would have been obvious to one of ordinary skill in the art to modify Bryant with the steps of "transmitting the correlation results to one or more prospective advertisers", "receiving one or more bids for each group of subavails" and "selling the group of subavails to the highest bidder" so as to maximize revenue for the content provider.

In regard to claim 8, the Bryant discloses a system and method of distributing demographically targeted advertisements. Bryant fails to explicitly disclose the claimed steps of "receiving information about one or more advertisements to be placed in the subavails", "characterizing the advertisements" and "correlating the advertisements and the subscriber groups, whereby the advertisements are inserted in the subavails based on the correlation". The Eldering reference teaches the steps of "receiving information about one or more advertisements to be placed in the subavails", "characterizing the

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advertisements” and “correlating the advertisements and the subscriber groups, whereby the advertisements are inserted in the subavails based on the correlation” as show in Figure 7, so as to maximize revenue for the content provider. The claimed step of “receiving information about one or more advertisements to be placed in the subavails” is met by Figure 7. “Advertiser 144 then transmits an ad characterization 710. The ad characterization can be received by content/opportunity provider 160 or directly by profiler 140” (Page 22, Lines 6-9). The claimed step of “characterizing the advertisements” is met by Figure 7. “Profile 140 retrieves consumer characteristics which can be in the form of probabilistic information regarding the consumer, deterministic data regarding the consumer, or product preference information” (Page 22, Lines 21-24). The claimed step of “correlating the advertisements and the subscriber groups, whereby the advertisements are inserted in the subavails based on the correlation” is also met by Figure 7. “Profiler 140 performs a correlation operation, the results of which are transmitted as a correlation factor or other correlation result to content/opportunity provider 160. In a preferred embodiment a pricing/fee arrangement message which represents the price for providing the advertisement as well as a fee for performing the correlation or accessing the consumer profile is transmitted along the correlation result” (Page 22, Lines 25-32). Consequently, it would have been obvious to one of ordinary skill in the art to modify Bryant with the steps of “receiving information about one or more advertisements to be placed in the subavails”, “characterizing the advertisements” and “correlating the advertisements and the subscriber groups,

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whereby the advertisements are inserted in the subavails based on the correlation" so as to maximize revenue for the content provider.

In regard to claim 9, the combined teaching fails to explicitly disclose that the subavails are grouped by combining a plurality of subavails across different channels. However, the examiner takes OFFICIAL NOTICE that it is notoriously well known to group plurality of advertisements across different channels so as to increase the chance of the profiled subscriber receiving the targeted advertisement over a channel range. Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify the combination of Bryant and Eldering to have subavails that are grouped by combining a plurality of subavails across different channels so as to increase the chance of the profiled subscriber receiving the targeted advertisement over a channel range.

In regard to claim 11, the combined teaching fails to explicitly disclose that the subavails are gathered from the same channel. However, the examiner takes OFFICIAL NOTICE that it is notoriously well known to have advertisements that are gathered from the same channel so as to increase the chance of the profiled subscriber receiving the targeted advertisement over time. Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify the combination of Bryant and Eldering to have subavails that are gathered from the same channel so as to increase the chance of the profiled subscriber receiving the targeted advertisement over time.

In regard to claim 13, Bryant discloses a system and method of distributing demographically targeted advertisements. Bryant fails to explicitly disclose "selling the

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groups of subavails to one or more prospective advertisers". Eldering teaches selling advertisements opportunities to one or more advertiser so as to generate revenue for the content provider. "In a preferred embodiment of the present invention, a pricing policy can be defined. The content/opportunity provider 160 can charge advertiser 144 for access to consumer 100 during an opportunity" (Page 9, Lines 1-4). Consequently, it would have been obvious to one of ordinary skill in the art to modify Bryant to sell advertisements opportunities to one or more advertiser so as to generate revenue for the content provider.

In regard to claim 16, the combined teaching fails to explicitly disclose that the subavails are grouped by combining a plurality of subavails across different channels. However, the examiner takes OFFICIAL NOTICE that it is notoriously well known to group plurality of advertisements across different channels so as to increase the chance of the profiled subscriber receiving the targeted advertisement over a channel range. Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify the combination of Bryant and Eldering to have subavails that are grouped by combining a plurality of subavails across different channels so as to increase the chance of the profiled subscriber receiving the targeted advertisement over a channel range.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 703-305-0345. The examiner can normally be reached on M-F: 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JM

February 14, 2005



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